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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/762,517

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Klaus Moritzen

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HARNESS, DICKEY & PIERCE, P.L.C.

P.O.BOX 8910

RESTON, VA 20195

EXAMINER

LAMBERT, JACOB M

ART UNIT

PAPER NUMBER

4176

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/762,517	Applicant(s) MORITZEN, KLAUS	
	Examiner JACOB LAMBERT	Art Unit 4176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-102 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-102 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20040123 and 20070209</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 91-102** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 (process, machine, manufacture, or composition of matter). A computer signal does not define any structural and functional interrelationships between the computer application and other claimed elements of a computer which permit the computer application's functionality to be realized.

Furthermore, as to claims 91-102, the claimed language, "carrier wave", does not constitute a statutory process, machine, manufacture, or composition of matter.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-102 are rejected under 35 U.S.C. 102(e) as being anticipated by Stefik et al. (US 6,708,157).

Regarding **claims 1, 15, 16, 30, 44, 51-53, 60, 66, 67, 68, 75-86, and 91**, Stefik et al. disclose a prepaid licensing system, method, and computer-readable medium comprising: storing information for licensing at least one prepaid use of software on a machine, the information including unique and unchangeable information identifying the machine, and information for measuring a number of uses of the software on the machine; and locally granting a license for the number of prepaid uses of the software on the machine, based upon the stored information (see in particular column 4, lines 11-33).

Regarding **claims 2, 17, 31, and 94**, in the system, method, and computer-readable medium of Stefik et al. the step of locally granting the license includes counting a number of uses of the software on the machine (see in particular column 6, lines 64-67).

Regarding **claims 3, 4, 18, 19, 32, 33, 45, 46, 54-59, 61, 69-74, 87-90, 95, and 96**, in the system, method, and computer-readable medium of Stefik et al., the

prohibiting operation of at least one of the software and the machine upon the count reaching zero (see in particular column 7, lines 20-27, the session is terminated after validity is checked and prohibited after access check. Also, error message is visual and audible indication).

Regarding **claims 5, 7, 20, 22, 34, 36, and 97**, in the system, method, and computer-readable medium of Stefik et al., the step of locally granting the license includes comparing the stored unique and unchangeable information to actual information identifying the machine on which the software will be used (see in particular column 11, lines 15-27 or column 12, lines 36-62 through column 13 lines 1-25, which discuss copy authorization and access prevention).

Regarding **claims 6, 8, 21, 23, 35, 37, 47, 62, 98, 99, and 100**, in the system, method, and computer-readable medium of Stefik et al. the prohibiting operation of at least one of the software and the machine upon determining that the comparison does not match (see in particular column 11, lines 15-27 or column 12, lines 36-62 through column 13, lines 1-25, which discusses copy authorization and access prevention).

Regarding **claims 9, 10, 11, 24, 25, 26, 38, 39, 40, 48, 49, 63, 64, and 101**, in the system, method, and computer-readable medium of Stefik et al. the at least a portion of the stored information is encrypted (see in particular column 8, lines 13-16).

Regarding **claims 12, 13, 14, 27, 28, 29, 40, 41, 42, 50, 65, and 102**, in the system, method, and computer-readable medium of Stefik et al. the machine is a

medical device (see in particular column 8, lines 18-26, which discloses a rendering device and system).

Regarding **claim 92**, in the computer signal of Stefik et al., is embodied on a carrier wave (see in particular column 14, lines 24-36, which discloses a signal exchanged over a network).

Regarding **claim 93**, in the computer signal of Stefik et al., is embodied in an email (see in particular column 26, lines 29-59, which discuss electronic message transmission).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JACOB LAMBERT whose telephone number is (571) 270-5396. The examiner can normally be reached on Monday to Thursday 730 to 5 ET.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/J. L./
Examiner, Art Unit 4176
May 8, 2008

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 4176